

SMS001/135211

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Sallas et al.

Serial No.: 10/812,365

Group No.: 3765

Date Filed: 03/22/2004

For: Infant Pants Having Knee Pockets and  
Replaceable Knee Pads

Examiner: Patel, Tajash D.

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF PRIOR INVENTION IN THE UNITED STATES  
OR IN A NAFTA OR WTO MEMBER COUNTRY  
TO OVERCOME CITED PATENT OR PUBLICATION (37 C.F.R. § 1.131)**

*NOTE: 37 C.F.R. § 1.131 Affidavit or declaration of prior invention.*

*(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:*

*(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n); or*

*(2) The rejection is based upon a statutory bar.*

## PURPOSE OF DECLARATION

1. This declaration is to establish completion of the invention of this application in

- ☒ the United States
- ☐ the NAFTA country (name of country)
- ☐ the WIPO country (name of country)

at a date prior to September 8, 2003, that is the effective date of the prior art

- ☐ publication \_\_\_\_\_
- ☒ patent U.S. 6,751,804 issued to Warner et al. on June 22, 2004
- ☐ patent publication \_\_\_\_\_
- ☐ other \_\_\_\_\_

that was cited by the

- ☒ examiner.
- ☐ applicant.

*NOTE: 37 C.F.R. § 1.131 is not applicable to a rejection based on a U.S. patent that CLAIMS the rejected invention.*

2. The person making this declaration is (are):

- ☒ the inventor(s).
- ☐ only some of the joint inventor(s) (and a suitable excuse is attached for failure of the omitted joint inventor(s) to sign)
- ☐ the party in interest (and a suitable explanation as why it is not possible to produce the declaration of the inventor(s) is attached)

## FACTS AND DOCUMENTARY EVIDENCE

*NOTE: "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained." 37 C.F.R. § 1.131(b).*

3. To establish the date of completion of the invention of this application, the following attached documents and/or models are submitted as evidence:

(check all applicable items below)

- ☒ sketches
- ☐ blueprints
- ☐ photographs
- ☐ reproduction(s) of notebook entries
- ☒ model
- ☐ supporting statement(s) by witness(es) (where verbal disclosures are the evidence relied upon)
- ☐ interference testimony
- ☒ disclosure documents

*NOTE: While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See Mergenthaler v. Scudder 1897 C.D. 724, 81 O.G. 1417." See also M.P.E.P. § 715.07 and § 2138.04, 7th ed.*

4. From these documents and/or models, it can be seen that the invention in this application was made

- ☐ on \_\_\_\_\_.
- ☒ at least by the date of August 27, 2003, which is a date earlier than the effective date of the reference.

*NOTE: "If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration." M.P.E.P. § 715.07, 8th ed.*

*NOTE: "[T]he dates in the oath or declaration may be the actual dates, or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided." M.P.E.P. § 715.07, 8th ed.*

### **DILIGENCE**

*NOTE: "Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of the actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, § 1.131)." M.P.E.P. § 715.07, 8th ed.*

*NOTE: "A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE OR SHE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME*

*OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited 1909 C.D. 498, 139 O.G. 991, M.P.E.P. § 715.07, 8th ed.*

*"Conception in the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." M.P.E.P. § 715.07, 8th ed.*

*NOTE: "[O]nly diligence before reduction to practice is a material consideration. The 'lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon' is not relevant to an affidavit or declaration under 37 CFR 1.131. See Ex parte Merz, 75 USPQ 296 (Bd. App. 1947)." MPEP § 715.07(a), 8th ed.*

5. Attached is a statement establishing the diligence of the applicants, from the time of their conception, to a time just prior to the date of the reference, up to the:

- ☐ actual reduction to practice.
- ☐ filing of this application.

#### **TIME OF PRESENTATION OF THE DECLARATION**

(complete (a), (b) or (c))

- (a) ☒ This declaration is submitted prior to final rejection.
- (b) ☐ This declaration is submitted with the first response after final rejection, and is for the purpose of overcoming a new ground of rejection or requirement made in the final rejection.
- (c) ☐ This declaration is submitted after final rejection. A showing under 37 C.F.R. § 1.116(b) is submitted herewith.

#### **DECLARATION**

6. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**SIGNATURE(S)**

7. (complete A or B below)

**A. Inventor(s)**

Full name of sole or first inventor: Margueritte Sallas

Inventor's signature: Margueritte Sallas

Date: March 2, 2005 Country of Citizenship: United States

Residence: 11900 Sallas Ranch Road, Montgomery, Texas 77356

Post Office Address: Montgomery, Texas 77356

Full name of second joint inventor, if any: Alicia McCarrell

Inventor's signature: Alicia McCarrell

Date: March 2, 2005 Country of Citizenship: United States

Residence: 11856 Sallas Ranch Road, Montgomery, Texas 77356

Post Office Address: Montgomery, Texas 77356

(use added page for signature by additional inventors)

Number of pages added: 0

**B. Assignee**

(type or print name of person signing)

Signature

Date

P.O. Address

(type name of assignee)

Address of assignee

Title of person authorized to sign on behalf of assignee

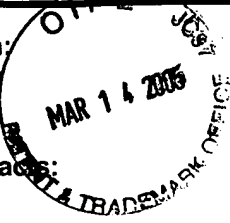
Assignment recorded in PTO on \_\_\_\_\_

Reel \_\_\_\_\_ Frame \_\_\_\_\_

☐ "CERTIFICATE UNDER 37 C.F.R. § 3.73(b)" is attached.

Jackson, Jim

From: Jackson, Jim  
Sent: Wednesday, August 27, 2003 10:50 AM  
To: 'kneekerbonkers@hotmail.com'  
Contact: Alicia McCarrell

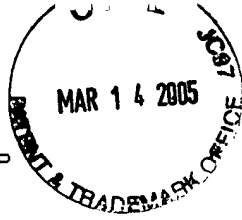


Ms. McCarrell: Thought I would get an update to you regarding the provisional application. I worked on it for a few hours last evening (wife is out of town and no grandchildren around) so I got a lot done. I should be able to finish the initial draft this evening and send it to you by e-mail.

I noticed that the actual infant pants that you sent to me are different from the sketches that you originally sent. In the drawings the knee pockets open near the bottom and the infant pants that you provided have knee pockets that open from the top and have a closure or pad retainer flap or panel that extends over the top of the pad and secures the pad within the pocket. My plan is to cover both versions in the patent application. I have to do some sketches that show the construction of the actual pants that you sent. Assuming that I get it all done this evening, I will need to fax the drawings to you tomorrow, so that you will be able to compare the drawings with the description that is set forth in the specification.

Then, assuming that there are no or few changes (you should feel free to make any changes that present the invention accurately), we should be able to send the application to the Patent and Trademark Office on Friday.

Regards, Jim Jackson

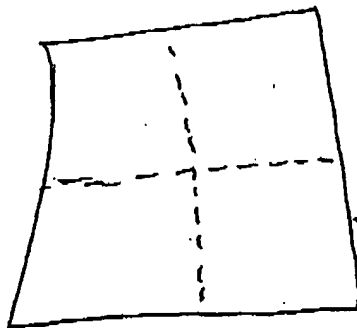


FROM : MAIL STOP

FAX NO. : 9367563220

Sep. 04 2003 03:18PM P1

pad: will be From mid-thigh  
to mid-calf so IF crawling  
will still cover knee if outfit  
moves.



pad (cut in  
square)

\*square pad covered  
w/ lining material

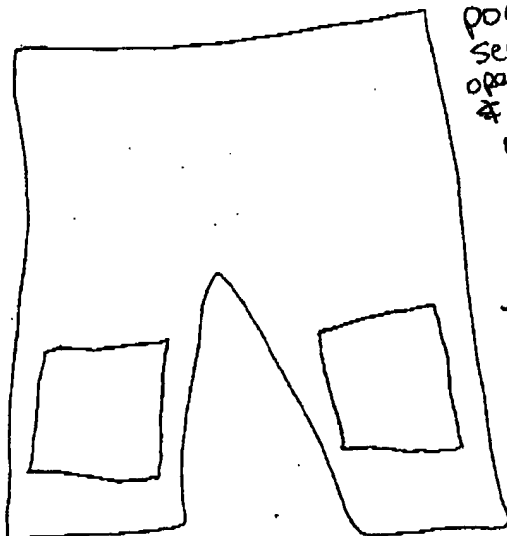
pocket on  
lined outfit  
where pad will  
go in.

(imagine a pillowcase)

fold over  
once pad is  
in.

Top of  
pocket where  
sewn at top &  
open @: bottom  
& goes over  
pad once tucked in.

stick pad  
in.  
Dotted line  
would be flap of  
pocket from  
bottom to top  
(sewn on bottom) (open top)  
stick pad in  
opening.



example of  
what inside  
out would  
look like.

(like  
sticking  
a pillow  
in a  
pillowcase.  
(pillowsham)



# QUESTIONS:

Call Alicia OR Marguer  
@: 936-597-4554  
OR 936-588-3340

\* Pants & overalls are completely lined w/ inseam lining material.

Pockets for pads are on lining material (Not on actual outfit). Pads are going to be made of Foam-

Sealant which is about 1/4" thick  
(very light in weight)

& it comes pre-made in large roll & we purchase it from HOME DEPOT. You can cut the foam easily & what we're doing is sewing the inseam lining around the foam pad so it will look good. Pads will be easily inserted & removable. Picture on next page.